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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/663,381      | 09/15/2003  | Andy Kazmierczak     | DJORTH.220A         | 1613             |

20995 7590 06/14/2005

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| EXAMINER |
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ALI, SHUMAYA B

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3743

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,381

Applicant(s)

KAZMIERCZAK ET AL.

Examiner

Shumaya B. Ali

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 10-12 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 13 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: response to arguments.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 3/28/2005 have been fully considered but they are not persuasive for the following reasons:

2. **In response to applicant's argument that there is no suggestion to combine the references (page 6, lines 10-13; page 7 lines 18-21):** the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gaylord does not disclose or suggest a support pillow having medial and lateral surfaces, wherein a distance between anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surface, however as to the limitation, Jagdat teaches as depicted in figure 1, where the pillow meets the particular dimension/shape required by the applicant (the width of one edge, labeled fig.1 anterior edge, is considered to be wider than its opposite edge, labeled fig.1 posterior edge). It is obvious to one of ordinary skills in the art to consider a pillow as a cushioning support. Therefore, it would have been obvious to one of ordinary skills in the art to substitute the cushion of Gaylord in view of Jagdat as a design preference since either pillow would be capable of providing a cushioning support to the user. Additionally, the structure of the cushioning mean of Gaylord in view of Jagdat is inherently capable of providing a particular angle of abduction and external rotation since applicant has suggested that the magnitude of rotational angle depends on the size and shape of the pillow (see page 5, 0024, lines 7-8).

3. **In response to applicant's argument that Jagdat pillow is nonanalogous art, Jagdat disclosure is considered analogous art (page 7 lines 22-24):** since both the applicant and Jagdat

disclose a pillow, which by definition is a cushion to support. Whether one uses the pillow disclosed by the applicant, Gaylord, or Jagdat, they all are pertaining to provide a cushioning support.

4. In regards to **“Jagdat makes no suggestion or motivation of using the pillow therein in a shoulder sling” (page 7 lines 29-30)**, however, Gaylord in view of Jagdat teaches substitution of one cushioning means for another. Additionally, applicant agrees, **“the pillow in Jagdat has a similar shape to applicants support pillow” (page 7 lines 28-29)**. Therefore, as discussed above, the shoulder sling in combination with a pillow is disclosed by Gaylord and Jagdat cures for the particular shape/size of the pillow required by the applicant. Since Gaylord and Jagdat both disclose a cushioning mean, it would have been obvious to one of ordinary skills in the art to substitute/prefer one cushioning mean over another for the purposes of providing a cushioning support.

5. Regarding **“combination of Gaylord Jagdat and Schaefer does not disclose or suggest at least a support pillow including a straight indicator line that provides a visual cue to the wearer so that the wearer knows when the sling is properly fitted” (page 9 lines 8-10)**: Schaefer teaches anterior and posterior strap attachment respectively to the anterior and posterior surface of the pillow. Additionally teaches hook and look type fastening means on the pillow surface to secure the straps to the pillow. Evidently the fastening means on the pillow gives a sense/indication to a wearer where the ends of the straps would most likely to attach. Therefore, the fastening means would be considered visual indicators capable of allowing proper fitting of the abduction device by ensuring proper alignment /attachment of the straps to the pillow.

6. Regarding **“Gaylord does not disclose or suggest a shoulder sling for supporting a wearer’s arm at a desired angle of external rotation” (page 10, lines 4-5)**: as discussed above Gaylord in view of Jagdat is inherently capable of providing external rotation. Gaylord and Jagdat and in further view of Itoi

US Patent 2004/129278, Itoi teaches a shoulder dislocation orthosis with a support block having a curved portion which follows the shape of the abdominal part of a body, an arm supporting side face which is extended forward from both ends of the curved portion to create an angle of 5-10 degrees external rotation (see page 2 0041 lines 6-7, 0044). Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the pillow of Gaylord in view of Jagdat in order to provide a particular shape/size of the pillow as a design preference or in further view of Itoi's teaching regarding the criticalities associated with a curved shoulder support in providing a prescribed angle range of external rotation for the purposes of allowing shoulder dislocation to heal (see Itoi, 0012 lines 1-5, 0017 lines 5-7).

7. Regarding "neither Gaylord nor Schaefer teaches or suggests a chest strap adapted to support an anterior portion of the support pillow and suspend the anterior portion of the support pillow from an anterior edge of the shoulder pad" (page 10 lines 12-14) and "a back strap adapted to support a posterior portion of the support pillow" (page 10 lines 15-16): "adapted to" not recited in the original disclosure, therefore, claimed limitation is not considered on the merit.

8. **Claims 1-6,8-9,13,15-25 stand rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 12/29/2004 and with above clarification set forth on the rejection ground.**

### ***Conclusion***

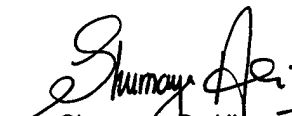
9. The prior art made of record on form PTO-892, US Patent 4,716,895 disclose Velcro adjustment means on a sling acting as an indicator aiding a patient exactly how to put the sling on.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Shumaya B. Ali** whose telephone number is **571-272-6088**. The examiner can normally be reached on M-F 8:30 am-4: 30 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Henry Bennett** can be reached on **571-272-4791**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-6088.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shumaya B. Ali  
Examiner  
Art Unit 3743  
6/9/2005

  
Henry Bennett  
Supervisor Patent Examiner  
Group 3700